

said claims consistent with the respective claims from which they depend.

In view of the foregoing Amendments and the following Remarks, the application is deemed to be in condition for allowance. Reconsideration of, and withdrawal of, the Final Rejection, and allowance of pending claims 41-56, 58, 59 and 61-70 is, therefore, respectfully requested.

I. THE 35 U.S.C. §112 OBJECTIONS AND "FORMAL MATTERS":

The Examiner objected to claims 63 and 58 for formal reasons. In response to the objection to claim 58, Applicant has amended claim 58, lines 5-6, so that the pertinent portion of said claim, as amended, recites "one of said educational material, a segment of said educational material, and a portion of said educational material". In response to the objection to claim 63, Applicant has amended claim 63, at each of lines 2 and 6, so as to change "processor" to -- processing device --.

In view of the above amendments to claims 58 and 63, Applicant submits that claims 58 and 63 are in compliance

with 35 U.S.C. §112. Withdrawal of the objection to claims 58 and 63 is, therefore, respectfully requested.

Applicant has also amended claim 61 so as to change "processor" to -- processing device -- throughout said claim so as to make claim 61 consistent with claim 41 from which claim 61 depends. Applicant has also amended claim 64 so as to change "processor" to -- processing device -- throughout said claim so as to make claim 64 consistent with claims 41 and 61 from which claim 64 depends.

II. THE 35 U.S.C. §103 REJECTIONS:

The Examiner asserts that claims 41-48, 53-56, 58, 61-63 and 65-70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg (World Wide Web - Course Tool: An Environment for Building WWW-Based Courses) (Goldberg) in view of Houstis et al. (Internet, Education, and the Web) (Houstis). The Examiner further asserts that claims 49 and 50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg in view of Houstis and further in view of McCarton (Virtual MBA).

Applicant respectfully submits that the Examiner's rejection of the pending claims is untenable. Applicant submits that the present invention, as defined by claims 41-56, 58, 59, and 61-70, is patentable over the prior art. Applicant respectfully requests reconsideration of the above rejection in view of the following remarks.

Applicant hereby incorporates and reasserts his comments and remarks regarding Goldberg and McCarton which were presented in Applicant's Amendment and Response to Office Action, dated November 5, 1999.

In the Office Action, dated January 28, 2000, the Examiner, at page 5, asserted the following:

"Regarding claims 41, 65, 66 and 69, Goldberg does not disclose education material which is at least one of video material, audio material, and video and audio material. Houstis et al discloses a distance learning system wherein the education material is preferably in multimedia form. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the distance learning system of Goldberg with multimedia education material as disclosed by Houstis et al. The rationale is as follows: it would have been desirable to transmit multimedia educational material in a remote education system in order to provide a more conducive learning environment for the student. As Houstis et al teaches the desirability of providing multimedia educational material, one of ordinary skill in the art would have been motivated by Houstis et al's teaching to provide

the remote education system of Goldberg with multimedia educational material, thereby providing an educational system which is more interesting and compelling to a student as compared to a remote education system which utilizes only text and graphics". Office Action, dated January 28, 2000, page 5, lines 6-18.

Applicant respectfully submits that the Examiner's reasoning in support of his rejection of the pending independent claims 41, 65, 66 and 69, and the claims which depend respectively therefrom, is untenable. Applicant further submits that the Examiner has failed to establish a *prima facie* case for obviousness as required by 35 U.S.C. §103. Applicant further submits that the Examiner's asserted obvious determination is contrary to controlling case law governing obviousness determinations, as set forth by the Court of Appeals for the Federal Circuit in In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998).

With regards to independent claims 41, 65, 66, and 69, Applicant respectfully submits that the Examiner has failed to show any teaching, suggestion, or motivation, in Goldberg or in Houstis for combining the teachings of said references in arriving at his determination of obviousness. The Examiner relies on Houstis for the teaching of the desirability of providing multimedia educational material.

Applicant submits that the Houstis teaching, of the desirability of providing multimedia educational material, does not provide any motivation for, or basis or suggestion for, combining the teachings of Houstis with the teachings of Goldberg. Assuming, arguendo, that Goldberg and Houstis could be combined in the manner espoused by the Examiner, any resulting combination would fail to disclose or suggest all of the claim limitations of independent claims 41, 65, 66 and 69.

Applicant respectfully submits that the present invention, as defined by claims 41-56, 58, 59 and 61-64, is patentable over Goldberg in view of Houstis. Applicant submits that the present invention, as defined by independent claim 41, is patentable over Goldberg in view of Houstis.

Applicant submits that Goldberg, Houstis, or any combination thereof, does not disclose or suggest an apparatus having the recited features of independent claim 41 which comprises a processing device which at least one of identifies, records, and stores, a first location, wherein the first location is the location in the recited educational material where the transmission of the

educational material is terminated, and further wherein a subsequent transmission of the educational material to the individual commences from the first location, all of which features are specifically recited features of independent claim 41.

Applicant submits that Goldberg does not disclose or suggest an apparatus and method which provides any one or more of video, audio, and/or combined audio and video (and/or audio-visual), educational material which can be monitored pursuant to the present invention. Applicant submits that Goldberg is directed to a web-based course consisting of note pages created by the course-author as described on page 4, second full paragraph, of said reference. Further, Applicant submits that Goldberg does not disclose or suggest any monitoring of any of the audio information or images disclosed therein.

The Examiner relies on Houstis for the teaching of the desirability of providing multimedia educational material. Applicant, however, submits that Houstis does not disclose or suggest any monitoring of, or related to, the multimedia educational material disclosed therein. In view of the above, Applicant submits that neither Goldberg

nor Houstis provides any motivation or suggestion for combining the references in the manner espoused by the Examiner.

Applicant further respectfully submits that the mere teaching by Houstis, of the desirability of providing multimedia educational material, is cumulative to, and adds nothing to, the teachings of Goldberg.

Applicant respectfully submits that the Examiner has failed to show any motivation for combining the teachings of Houstis with the teachings of Goldberg. Instead, Applicant submits that the Examiner has improperly utilized hindsight to piece together the elements of the present invention, as defined by independent claim 41, from the teachings of Goldberg and Houstis only after using Applicant's claimed invention as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350).

The Court of Appeals for the Federal Circuit in In Re Rouffet, stated:

"Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357 (Fed. Cir. 1998).

In view of the foregoing, Applicant submits that the present invention, as defined by independent claim 41, and claims 42-56, 58, 59 and 61-64 which claims depend from independent claim 41, is patentable over Goldberg in view of Houstis. The Examiner's reconsideration of, and withdrawal of, the final rejection of claims 41-56, 58, 59, and 61-64, and the allowance of said claims, is, therefore, respectfully requested.

Applicant respectfully submits that the present invention, as defined by independent claim 65, is patentable over Goldberg in view of Houstis. Applicant submits that Goldberg, Houstis, or any combination thereof, does not disclose or suggest an apparatus having the recited features of independent claim 65 which comprises a processing device, wherein the processing device terminates

the transmission of the recited educational material in response to the termination signal, and further wherein the processing device at least one of identifies, records, and stores, a first location, wherein the first location is the location in the educational material where the transmission of the educational material is terminated, and further wherein a subsequent transmission of the educational material to the individual commences from the first location, all of which features are specifically recited features of independent claim 65.

Applicant further submits that Goldberg, Houstis, or any combination thereof, does not disclose or suggest the recited transmitter for transmitting the recited educational material to the individual, wherein the educational material is transmitted to the individual without individual intervention subsequent to an initiation of the transmission of the educational material, which are still other specifically recited features of independent claim 65.

Applicant hereby incorporates the arguments presented above in conjunction with independent claim 41. As noted above, Applicant submits that Goldberg does not

disclose or suggest an apparatus and method which provides any one or more of video, audio, and/or combined audio and video (and/or audio-visual), educational material which can be monitored pursuant to the present invention. Applicant submits that Goldberg is directed to a web-based course consisting of note pages created by the course-author as described on page 4, second full paragraph, of said reference. Further, Applicant submits that Goldberg does not disclose or suggest any monitoring of any of the audio information or images disclosed therein.

The Examiner relies on Houstis for the teaching of the desirability of providing multimedia educational material. Applicant, however, submits that Houstis does not disclose or suggest any monitoring of, or related to, the multimedia educational material disclosed therein. Applicant submits that neither Goldberg nor Houstis provides any motivation or suggestion for combining the references in the manner espoused by the Examiner.

Applicant respectfully submits that the mere teaching by Houstis, of the desirability of providing multimedia educational material, is cumulative to, and adds nothing to, the teachings of Goldberg.

Applicant respectfully submits that the Examiner has failed to show any motivation for combining the teachings of Houstis with the teachings of Goldberg. Instead, Applicant submits that the Examiner has improperly utilized hindsight to piece together the elements of the present invention, as defined by independent claim 65, from the teachings of Goldberg and Houstis only after using Applicant's claimed invention as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350).

In view of the above, Applicant respectfully submits that the present invention, as defined by independent claim 65, is patentable over Goldberg in view of Houstis. The Examiner's reconsideration of, and withdrawal of, the final rejection of claim 65, and the allowance of said claim, is, therefore, respectfully requested.

Applicant respectfully submits that the present invention, as defined by claims 66-68, is patentable over Goldberg in view of Houstis. Applicant submits that the

present invention, as defined by independent claim 66, is patentable over Goldberg in view of Houstis.

Applicant submits that Goldberg, Houstis, or any combination thereof, does not disclose or suggest the method having the recited features of independent claim 66 which comprises at least one of identifying, recording, and storing, a first location, wherein the first location is the location in the recited educational material where the transmission of the educational material is terminated, all of which features are specifically recited features of independent claim 66. Applicant further submits that Goldberg, Houstis, or any combination thereof, does not disclose or suggest commencing a subsequent transmission of the recited educational material to the individual from the first location, which are still other specifically recited features of independent claim 66.

Applicant hereby incorporates the arguments presented above in conjunction with independent claims 41 and 65. Applicant submits that Goldberg does not disclose or suggest an apparatus and method which provides any one or more of video, audio, and/or combined audio and video (and/or audio-visual), educational material which can be

monitored pursuant to the present invention. Applicant submits that Goldberg is directed to a web-based course consisting of note pages created by the course-author as described on page 4, second full paragraph, of said reference. Further, Applicant submits that Goldberg does not disclose or suggest any monitoring of any of the audio information or images disclosed therein.

The Examiner relies upon Houstis for the teaching of the desirability of providing multimedia educational material. Applicant, however, submits that Houstis does not disclose or suggest any monitoring of, or related to, the multimedia educational material disclosed therein. Applicant submits that neither Goldberg nor Houstis provides any motivation or suggestion for combining the references in the manner espoused by the Examiner.

Applicant respectfully submits that the mere teaching by Houstis, of the desirability of providing multimedia educational material, is cumulative to, and adds nothing to, the teachings of Goldberg.

Applicant respectfully submits that the Examiner has failed to show any motivation for combining the teachings

of Houstis with the teachings of Goldberg. Instead, Applicant submits that the Examiner has improperly utilized hindsight to piece together the elements of the present invention, as defined by independent claim 66, from the teachings of Goldberg and Houstis only after using Applicant's claimed invention as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350).

In view of the above, Applicant respectfully submits that the present invention, as defined by independent claim 66, as well as claims 67 and 68, is patentable over Goldberg in view of Houstis. The Examiner's reconsideration of, and withdrawal of, the final rejection of claims 66-68, and the allowance of said claims, is, therefore, respectfully requested.

Applicant respectfully submits that the present invention, as defined by claims 69-70, is patentable over Goldberg in view of Houstis. Applicant submits that the present invention, as defined by independent claim 69, is patentable over Goldberg in view of Houstis.

Applicant submits that Goldberg, Houstis, or any

combination thereof, does not disclose or suggest an apparatus having the recited features of independent claim 69 which comprises a means for at least one of identifying, recording, and storing, a first location, wherein the first location is the location in the recited educational material where the transmission of the educational material is terminated, all of which features are specifically recited features of independent claim 69. Applicant further submits that Goldberg, Houstis, or any combination thereof, does not disclose or suggest means for commencing a subsequent transmission of the recited educational material to the individual from the first location, which are still other specifically recited features of independent claim 69.

Applicant hereby incorporates the arguments presented above in conjunction with independent claims 41, 65 and 66. Applicant submits that Goldberg does not disclose or suggest an apparatus and method which provides any one or more of video, audio, and/or combined audio and video (and/or audio-visual), educational material which can be monitored pursuant to the present invention. Applicant submits that Goldberg is directed to a web-based course consisting of note pages created by the course-author as

described on page 4, second full paragraph, of said reference. Further, Applicant submits that Goldberg does not disclose or suggest any monitoring of any of the audio information or images disclosed therein.

The Examiner relies upon Houstis for the teaching of the desirability of providing multimedia educational material. Applicant, however, submits that Houstis does not disclose or suggest any monitoring of, or related to, the multimedia educational material disclosed therein. Applicant submits that neither Goldberg nor Houstis provides any motivation or suggestion for combining the references in the manner espoused by the Examiner.

Applicant respectfully submits that the mere teaching by Houstis, of the desirability of providing multimedia educational material, is cumulative to, and adds nothing to, the teachings of Goldberg.

Applicant respectfully submits that the Examiner has failed to show any motivation for combining the teachings of Houstis with the teachings of Goldberg. Instead, Applicant submits that the Examiner has improperly utilized hindsight to piece together the elements of the present

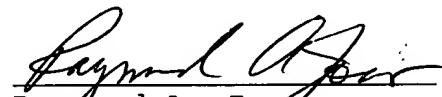
invention, as defined by independent claim 69, from the teachings of Goldberg and Houstis only after using Applicant's claimed invention as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350).

In view of the above, Applicant respectfully submits that the present invention, as defined by independent claim 69, as well as claim 70, is patentable over Goldberg in view of Houstis. The Examiner's reconsideration of, and withdrawal of, the final rejection of claims 69-70, and the allowance of said claims, is respectfully requested.

III. CONCLUSION:

In view of the above, the application is deemed to be in condition for allowance. Withdrawal of the Final Rejection, and allowance of the pending claims, is, therefore, respectfully requested.

Respectfully Submitted,


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